



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/445,278	06/25/2001	Peter Boutsalis	PB/5-30021/A	9741

1095 7590 04/22/2003

THOMAS HOXIE
NOVARTIS, CORPORATE INTELLECTUAL PROPERTY
ONE HEALTH PLAZA 430/2
EAST HANOVER, NJ 07936-1080

EXAMINER

GRUNBERG, ANNE MARIE

ART UNIT	PAPER NUMBER
----------	--------------

1661

DATE MAILED: 04/22/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/445,278

Applicant(s)

Peter Boutsalis

Examiner

Anne Marie Grunberg

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 27, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-31 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

Art Unit: 1661

DETAILED ACTION

Claims 22-31 are pending.

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119 (a)-(d). The certified copy of the British Application No. 9802250.2, filed on 3/02/1998 has been received.
2. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Germany on 4/6/1997. It is noted, however, that applicant has not filed a certified copy of the German application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 22-23, 26, and 28-31 (newly amended) and dependent claims 24-25, and 27 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to

Art Unit: 1661

particularly point out and distinctly claim the subject matter which applicant regards as the invention. No new matter may be added in order to clarify any definitions.

In claim 22, it is unclear what constitutes a "short" segment. This is not defined in the specification, nor would it be readily apparent to one of skill in the art what the definition of "short" entails. It is also unclear what constitutes a "root and shoot fragment" nor is it clear what constitutes a "short" root and shoot fragment. If the roots and branches are cropped such as often occurs in the horticultural industry with roses for example, is it a "root and shoot" fragment. Although Applicant attempted to remedy this problem by defining a "short segment" as one that "comprises a short root and shoot fragment and is capable of directly regenerating into a whole and morphologically normal plant" the regeneration is simply an added limitation that does not define "short". It also does not define "root and shoot" fragment.

In claim 23 it is unclear, nor is it defined in the specification what constitutes a "high" amount of actively dividing cells. Applicant attempted to address this situation with new claim 24. However, a narrower dependent claim can not be used to define the material in the claim upon which it is dependent.

Claim 26 is unclear in the recitation of "high through-put" which is not defined in the specification. How "high" is high?

Claim 28 lacks sufficient antecedent basis for "the pesticide". It appears that the language is intended to refer to "pesticidal compound". This rejection may be obviated by changing one of the terms to correspond with the other.

Art Unit: 1661

In claims 29-31, there is no antecedent basis for “plant to be tested”.

5. Claims 22-25 and 30 remain rejected under 35 U.S.C. 102(b) as being anticipated by Fehr.

Applicant argues that Fehr does not teach a method for verifying the resistance status of a field-grown plant exhibiting a resistance phenotype wherein a population of plants are exposed to the pesticide or pathogen under field conditions., thus placing the claims in condition for allowance.

This argument has been carefully considered but is not considered persuasive for the following reasons:

Fehr at page 386 states that the progeny were subjected to “clonal tests” that were used to evaluate potential value of the cultivars. The plants were planted in the infected field for this test.

6. Claims 22-25, 27 and 30 remain rejected under 35 U.S.C. 102(b) as being anticipated by J A Samson.

Applicant argues that Samson does not teach a method for verifying the resistance status of a field-grown plant exhibiting a resistance phenotype wherein a population of plants are exposed to the pesticide or pathogen under field conditions, thus placing the claims in condition for allowance.

Art Unit: 1661

This argument has been carefully considered but is not considered persuasive for the following reasons:

The progeny plants are incorporated into a plant screening program and further monitored (last line on page 37; page 46, third full paragraph; page 57, third paragraph; page 82, for example).

7. Claims 26-28 and 31 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Fehr in view of Benson.

Applicant argues that the combination does not teach or reasonably suggest the step of verifying the resistance status of a field-grown plant exhibiting a resistance phenotype wherein a population of plants are exposed to the pesticide or pathogen under field conditions.

Fehr at page 386 states that the progeny were subjected to "clonal tests" that were used to evaluate potential value of the cultivars. The plants were planted in the infected field for this test.

No claim is allowed.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


Art Unit: 1661

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie Grünberg whose telephone number is (703) 305-0805. The examiner can normally be reached from Monday through Thursday from 7:30 until 5:00, and every other Friday from 7:30 until 4:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Bruce Campell, can be reached at (703) 308-4205. The fax number for the unit is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


ANNE MARIE GRUNBERG
PATENT EXAMINER